

REMARKS

Claims **4-13, 17-39, and 41-48** were pending in this application. According to the June 21, 2007 Office Action, claims **4-13, 17-39, and 41-48** were rejected.

We have amended independent claims **4** and **17**, have amended dependent claims **5-13, 18-26, 28-30, 32-38, and 44-48**, and have added new dependent claims **49-60** to recite particular embodiments that we, in our business judgment, have currently determined to be commercially desirable. We have canceled dependent claims **27, 31, and 41-43**. We will pursue the subject matter of the previously presented and canceled claims in one or more continuing applications. The amendments do not introduce any new matter.

Accordingly, the following claims are under consideration:

- Independent claims **4** and **17**.
- Dependent claims **5-13, 18-26, 28-30, 32-39, and 44-60**.

1.0 Response to the rejection of claims 4-13, 17-39, and 41-48.

At pages 2-5 of the Office Action, claims **4-13, 17-39, and 41-48** were rejected under 35 U.S.C. § 103(a) as being unpatentable over Silverman et al., U.S. Patent No. 5,136,501 (hereinafter Silverman) in view of Togher et al., U.S. Patent 6,014,627 (hereinafter Togher). As indicated, dependent claims **27, 31, and 41-43** have been canceled.

As set forth in the MPEP, to establish a *prima facie* case of obviousness, (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and (2) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

Notably, a factual finding of a suggestion or motivation to modify a reference must be supported with substantial evidence of record. Novamedix Distrib. Ltd. v. Dickinson, 175 F. Supp. 2d 8, 9 (D.D.C. 2001); In re Zurko, 258 F.3d 1379, 1383-86 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1342 (Fed. Cir. 2002). In particular, conclusory statements regarding the factual question of motivation must be supported by evidence of record and without such evidence, lack substantial evidence support and are thereby insufficient to establish a *prima facie* case of obviousness. In re Lee, 277 F.3d at 1343-45; In re Zurko, 258 F.3d at 1385.

As further discussed below, the Examiner has not established a *prima facie* case of obviousness with respect to any of claims **4-13, 17-26, 28-30, 32-39, and 44-48** because the Examiner has not shown that the combination of Silverman and Togher teach, suggest, or disclose all the limitations of any of claims **4-13, 17-26, 28-30, 32-39, and 44-48** and because the Examiner has not provided any evidence of record to support a suggestion or motivation to modify Silverman in view of Togher.

Specifically, independent claim **4** recites in part a method comprising:

causing to be presented to at least a ... first trader and second trader an interface comprising a plurality of options on how ... to process pending trades that cause warning limits to be exceeded, the plurality of options including:

*... rejecting the pending trades, [and]
... executing in part the pending trades ...; [and]*

receiving from each of the first trader and the second trader a selection of one of the plurality of options.

In rejecting claim **4**, the Examiner asserted that Silverman discloses the above limitations of claim **4** at column 3, lines 18-38, column 19, lines 3-8, and column 20, lines 26-28. We respectfully disagree. At column 3, lines 18-38 Silverman discloses that “[e]ach of the ... client sites in the system assigns trading party credit limits to the other client sites in the system with which it is desired to trade, with these trading party credit limits ... being used by the host computer to anonymously determine gross counterparty credit limits for each potential matching transaction.” At column 19, lines 3-8 Silverman further discloses that “if in the course of matching you run up against a credit limit which causes the gross counterparty credit to be exceeded, then the matching trade occurs up to the gross counterparty limit.”

Accordingly, Silverman appears to disclose a system in which a first trader and a second trader assign credit limits against the other. However, the system of Silverman never “*present[s] to at least [the] ... first trader and second trader ... a plurality of options on how ... to process pending trades that cause [these credit limits] to be exceeded.*” Under Silverman, when a potential matching transaction between the first trader and second trader exceeds the credit limit of the first and/or second trader, the system automatically trades up to a lesser of the credit limits. The system never considers from “*each of the first trader and the second trader a selection of one of the plurality of options*” “*on how ... to process [the potential matching*

transaction when that transaction] ... cause[s] [these credit limits] to be exceeded.” In other words, contrary to the Examiner’s assertions, Silverman does not disclose “causing to be presented to at least a ... first trader and second trader an interface comprising a plurality of options on how ... to process pending trades that cause warning limits to be exceeded.” The assigning and use of credit limits as disclosed by Silverman is not “a plurality of options on how ... to process pending trades that cause warning limits to be exceeded,” as recited by claim 4.

Accordingly, contrary to the Examiner’s assertions, Silverman does not disclose the above limitations of claim 4 and as such, the Examiner has not established that the combination of Silverman and Togher teach, suggest, or disclose all the limitations of claim 4.

In further rejecting claim 4, the Examiner asserted that Silverman “does not explicitly teach executing in full the pending trades as part of the options on how to process pending trades that exceeds warning limit,” that Togher “teaches the option of ... executing in full the entire transaction,” and that one would have been motivated to “include in Silverman an option to execute in full the pending trades as taught by Togher” “in order to provide the traders with this additional option of completing the transaction regardless of the limit.”

Even assuming, *arguendo*, that Silverman discloses “causing to be presented to at least a ... first trader and second trader an interface comprising a plurality of options ... including: ... rejecting the pending trades, [and] ... executing in part the pending trades” and that Togher discloses “causing to be presented to at least a ... first trader and second trader an interface comprising a plurality of options ... including: ... executing in full the pending trades,” the Examiner has not provided any evidence of record to support a suggestion or motivation to combine these references. Specifically, the Examiner appeared to merely conclude that one would have been motivated to include in Silverman the additional option of “executing in full the pending trades” because doing such would provide traders with this additional option. However, such a statement is a mere conclusion and lacks any evidence to support the conclusion. The only evidence of record of the desirability of presenting to traders “a plurality of options on how ... to process pending trades that cause warning limits to be exceeded, the plurality of options including: ... rejecting the pending trades, ... executing in part the pending trades ...; [and] ... executing in full the pending trades” is Applicants’ own disclosure. However, Applicants’ disclosure is not prior art.

Accordingly, because Silverman and Togher fail to teach, suggest, or disclose the above limitations of claim 4 and because the Examiner has not provided evidence of record to support a suggestion or motivation to modify Silverman in view of Togher, the Examiner has not established a *prima facie* case of obviousness with respect to claim 4. Claim 4 is therefore nonobvious in view Silverman and Togher.

Turning to independent claim 17, this claim recites limitations similar to claim 4 and as such, is also nonobvious in view of Silverman and Togher for at least the reasons set forth above for claim 4.

Turning to dependent claims 5-13, 18-26, 28-30, 32-39, and 44-48, because these claims depend from claim 4 or claim 17, these claims are also nonobvious in view of Silverman and Togher for at least the reasons set forth above for claim 4.

2.0 Improper taking of official notice regarding claims 47 and 48.

In rejecting previously presented claims 47 and 48, the Examiner took official notice regarding the limitations of these claims. Officially-noted subject matter cannot be used as the primary basis for a rejection under § 103. In other words, official notice alone of what existed in the prior art is not permitted. A reference must be provided to show the scope and content of the prior art. see, e.g., In re Ahlert, 424 F.2d 1088 (C.C.P.A. 1969); In re Eynde, 480 F.2d 1364 (C.C.P.A. 1973); In re Pardo, 684 F.2d 912 (C.C.P.A. 1982). Accordingly, the Examiner has not established a *prima facie* case of obviousness with respect to previously presented claims 47 and 48. If the Examiner wishes to maintain the rejection of currently presented claims 47 and 48, it is requested that the Examiner provide documentary evidence to support the rejection. 37 C.F.R. 1.104(c)(2); MPEP § 2144.03(C).

3.0 Response to the rejection of claims 12, 13, 25, and 26.

The Examiner rejected previously presented claims 12, 13, 25, and 26 based on the same analyses of claims 4, 17, 47, and 48 (“See claims 4, 17, 47-48 analyses”). However, claims 12, 13, 25, and 26 recite limitations that are different from the limitations of claims 4, 17, 47, and 48. Accordingly, it is unclear how the analyses of claims 4, 17, 47, and 48 apply to claims 12, 13, 25, and 26. If the Examiner wishes to maintain the rejection of currently presented claims 12, 13, 25, and 26, we respectfully request that the Examiner clarify the rejection.

4.0 New dependent claims 49-60.

Turning to new dependent claims **49-60**, because these claims depend from claim **4** or claim **17**, these claims are also nonobvious in view of Silverman and Togher for at least the reasons set forth above for claim **4**.

5.0 Conclusion.

Since Silverman and Togher fail to teach or suggest claims **4-13, 17-26, 28-30, 32-39, and 44-60**, we submit that these claims are clearly allowable. Favorable reconsideration and allowance of these claims are therefore requested.

We earnestly believe that this application is now in condition to be passed to issue, and such action is also respectfully requested. However, if the Examiner deems it would in any way facilitate the prosecution of this application, the Examiner is invited to telephone our undersigned representative at 212-294-7733.

Respectfully submitted,

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Date

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